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# **PETITION FEE Under 37 CFR 1.17(f), (g) & (h) TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10/561,260
Filing Date	October 16, 2006
First Named Inventor	John Colgrave
Art Unit	3621
Examiner Name	Joshua A. Murdough
Attorney Docket Number	GB920030007US1

Enclosed is a petition filed under 37 CFR 1.181 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400.00 is enclosed.

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☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments

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## **Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

- § 1.36(a) - for revocation of a power of attorney by fewer than all applicants
- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

## **Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

## **Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

/Steven L. Nichols/

Signature

Steven L. Nichols

Typed or printed name

May 12, 2011

Date

40326

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of

John Colgrave

Application No. 10/561,260

Filed: **October 16, 2006**

For: User Access to a Registry of Business  
Entity Definitions

Group Art Unit: 3621

Examiner: Joshua A. Murdough

Confirmation No.: 5696

**PETITION TO THE DIRECTOR PURSUANT TO 37 C.F.R. § 1.181**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

On October 5, 2010, Applicant filed a declaration pursuant to 37 C.F.R. § 1.132 (the “Declaration”) as part of a response to a final office action dated August 4, 2010. In an “Advisory Action Before the Filing of an Appeal Brief” dated April 27, 2011 (the “Advisory Action”), Examiner Joshua Murdough refused to enter the Declaration on the grounds that the Declaration “failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons [sic] why it is necessary and was not earlier presented.” (Advisory Action, pp. 1-2) (citing 37 C.F.R. § 41.33(d)(1)). For at least the

following reasons, Applicant respectfully petitions the Director to compel entry of the Declaration.

### **STATEMENT OF RELEVANT FACTS**

1. In a non-final Office Action dated February 19, 2010, Examiner Murdough rejected claims 16-29 of the present application under 35 U.S.C. § 112, second paragraph as being indefinite because the Examiner viewed the terms “business entity definition,” “business service entity information element,” “binding template information element,” “technical model information element,” and “business entity information element” as being indefinite. In the Examiner’s view, “to one of ordinary skill in this art,” the metes and bounds of these phrases “can not be reasonably determined.” (Action of Feb. 19, 2010, pp. 13-16). The Examiner offered to withdraw this rejection “[u]pon receiving (1) Applicant’s express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof.” (*Id.*)

2. In response to the non-final Office Action of February 19, 2010, Applicant argued that the terms in question are well-known in the field of Universal Description Discovery and Integration (UDDI) registries, to which the specification is expressly directed, such that the terms would not be indefinite to one having ordinary skill in the relevant art. (Applicant’s Amendment of May 18, 2010, pp. 15-19). In support of this proposition, Applicant cited to an online version of the UDDI Specification, which clearly sets forth the meaning of the disputed terms. (*Id.* (citing UDDI Version 3.0.2 Specification, [http://www.uddi.org/pubs/uddi\\_v3.htm](http://www.uddi.org/pubs/uddi_v3.htm))).

3. In a final Office Action dated August 4, 2010, the Examiner refused to consider the online version of the UDDI Specification cited by Applicant in the previous Amendment. (Action of Aug. 4, 2010, pp. 18-19). The Examiner justified this course of action by stating that “because the date of publication is not known, the Examiner cannot make a determination whether the document is part of the prior art,” and therefore “cannot determine if the document is valid for establishing the phrase ‘business entity definition’ is old and well known.” (*Id.*, p. 19). Additionally, the Examiner stated in this Action that “if Applicant believes that [the disputed phrases are] old and well known in the art, Applicant should (*in their next appropriately filed response*) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof.” (*Id.*, pp. 5-9) (emphasis added). Thus, the Examiner expressly requested in the Final Office Action that Applicant provide *in its next response* verifiable evidence on the record that the disputed phrases are well-known in the art.

4. In response to the Examiner’s request in the Final Office Action, Applicant submitted the aforementioned Declaration on October 5, 2010. The Declaration includes four exhibits (Exhibits A-D). Each exhibit is a document published before the filing date of the present application which provides evidentiary support for Applicant’s position that the disputed phrases are well-known in the art. These documents describe the UDDI standard, which is well-known and accepted in the industry relevant to the present application.

5. Following submission of the Declaration, Applicant filed a Notice of Appeal on October 6, 2010 and an Appeal Brief on December 2, 2010. The Appeal Brief refers to exhibits of the Declaration as evidence for Applicant’s position that the Examiner has

improperly rejected claims 16-29 under 35 U.S.C. § 112, second paragraph. Indeed, these exhibits provide significant support for Applicant's position at appeal.

6. Nearly five months after filing the Appeal Brief and more than six months after filing the Declaration, the Examiner issued the Advisory Action stating the Examiner's refusal to enter Applicant's Declaration with its accompanying Exhibits on the grounds that the declaration "failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons [sic] why it is necessary and was not earlier presented." (Advisory Action, pp. 1-2) (citing 37 C.F.R. § 41.33(d)(1)).

#### **GROUND UPON WHICH RELIEF IS REQUESTED**

**1. The Examiner has erred in refusing to enter the Declaration pursuant to 37 C.F.R. § 41.33(d)(1).**

37 C.F.R. § 41.33(d)(1) is expressly directed to "an affidavit or other evidence *filed after the date of filing an appeal.*" (Emphasis added). By contrast, the record clearly shows that Applicant's Declaration was filed on October 5, 2010, the Notice of Appeal was filed on October 6, 2010, and the Appeal Brief was filed on December 2, 2010. As such, there can be no question that Applicant's Declaration was filed *before the date of filing an appeal.* As such, the Examiner's refusal to enter the Declaration pursuant to 37 C.F.R. § 41.33(d)(1) is wholly improper.

**2. The Examiner has erred in refusing to enter Applicant's Declaration on the grounds that Applicant has not provided good and sufficient reasons why the Declaration is necessary and was not earlier presented.**

The Examiner could not have reasonably concluded that Applicant's Declaration was not necessary. The Declaration provides evidentiary support to Applicant's position with respect to an outstanding rejection of Applicant's claims. Such evidence was requested by the Examiner in an Office Action, and is therefore necessary to provide a complete response to that Office Action.

With regard to timing, it should be understood that the Examiner requested this evidence in a Final Office Action. In response, Applicant submitted the Declaration within the statutory time period for responding to that Final Office Action. Consequently, the Examiner could not have reasonably expected Applicant to respond to his request any earlier than it did.

**3. The Examiner has erred in refusing to enter Applicant's Declaration using the "Advisory Action Before the Filing of an Appeal Brief" form.**

Again, Applicant filed an Appeal Brief on December 2, 2010. The Advisory Action is dated April 27, 2011. Without question the Advisory Action did not occur "before the filing of an Appeal Brief." (Emphasis added).

**4. Entry of Applicant's Declaration is Necessary to Fairly Decide the Pending Appeal.**

Applicant's Appeal Brief of December 2, 2010 maintains the position that the outstanding rejection of Applicant's claims under 35 U.S.C. § 112, second paragraph is improper. The exhibits in Applicant's Declaration provide persuasive evidence that the Examiner's position in making this rejection is without reasonable basis, and that the Examiner has not met his burden to establish the *prima facie* unpatentability of the rejected

claims. To this end, Applicant's Appeal Brief references the exhibits of the Declaration extensively.

If Applicant's Declaration is refused entry, the Board of Appeals and Patent Interferences will not have access to all of the evidence necessary to fairly decide whether the rejections made under 35 U.S.C. § 112 should be sustained or reversed. Furthermore, denying the Board access to relevant evidence is counterintuitive and unnecessarily complicates the appeal process.

**RELIEF REQUESTED**

In light of the above considerations, Applicant respectfully requests that the Director compel entry of Applicant's Declaration of October 5, 2010.

Respectfully submitted,

/Steven L. Nichols/

DATE: May 12, 2011

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